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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/554,343 | 12/06/2000 | Konstanze Saathoff | HHI-023US | 2211 |

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EXAMINER

MEISLIN, DEBRA S

| ART UNIT | PAPER NUMBER |
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3723

DATE MAILED: 01/09/2003

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 17

Application Number: 09/554,343
Filing Date: December 06, 2000
Appellant(s): SAATHOFF ET AL.

Neil F. Greenblum
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 29, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The "Summary of Invention" contained in the Brief is deficient because lines 1-3 of the "Summary of the Invention" is not supported by page 3, lines 23 and 24 of the specification as alleged by appellant. Lines 4-5 of the "Summary of Invention" contained in the Brief is not supported by page 3, lines 25-33 of the specification as alleged by appellant. The specification does not define a "ratchet drive with a torque limiter arranged in a conventional torque wrench". Lines 6-8 of the "Summary of Invention" contained in the Brief is not supported by page 3, line 34 - page 4, line 10 of the specification as alleged by appellant. Lines 37-38 of the "Summary of Invention" contained in the Brief is not supported by page 9, lines 8-23 of the specification and figures 1-2 of the drawings as alleged by appellant. Note page 9, line 9 defines "in a manner similar to a basically known torque limiter".

(6) Issues

The appellant's statement of the issues in the brief is correct.

Art Unit: 3723

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant's brief does not include reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 11.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office Action, Paper No. 11.

(11) *Response to Argument*

The structure of the articulated joint "8", the articulated body "9", the adapter "12", the spring "10", the motor, the torque limiter, the motorized portion of the device, the cooperation between the manual and motorized portions of the device, and the operative positions of the device have not been fully disclosed. Such structure cannot be ascertained from the specification and drawings. Appellant's arguments alone are insufficient to overcome a deficient specification and drawings.

Art Unit: 3723

Appellant contends that the individual elements of the instant application are well known, that the instant invention is directed to a combination of conventional wrenches into a single inventive tool, and that the individual construction and operation of the separate tools is well known to those ordinarily skilled in the art. The original specification does not support these statements. Additionally, if the individual construction of the separate tools is well known and the instant invention is directed to a combination of conventional wrenches into a single inventive tool, the structure that allows the two supposedly well known tool constructions to be combined would define a structure that is not well known. Consequently, it is not clear as to what is considered to be conventional and what is considered to be inventive with respect to the disclosed structure of the device. The specification does not clearly define what is considered to be conventional and what is considered to be inventive. Appellant's arguments alone are insufficient to overcome a deficient specification. An understanding of the invention must be ascertained from the original disclosure and not in view of arguments directed to similar art.

The term "motor-driven manual wrench" appears contradictory. The disclosure appears to disclose "a combination motor-driven and manual driven wrench".

The specification and drawings do not "structurally and operationally" support the elements recited in claims 2-3, 7-12, and 14-16. A mere recitation in the specification is insufficient unless the elements of claims 2-3, 7-12, and 14-16 have been defined as being conventional.

Art Unit: 3723

The examiner remains of the opinion that lines 3-7 of claim 6 are not understood in view of the specification and drawings.

The specification and drawings do not clearly define the structure of "a flat" output element.

It is noted that the drawings must show every feature of the invention specified in the claims. Appellant has failed to show the elements as set forth in claims 2-3, 7-12, and 14-16.

The specification must clearly indicate the structure of the device that is old in the art. Applicant's arguments alone are insufficient. An understanding of the invention must be ascertained from the original disclosure and not in view of arguments directed to similar cited art.

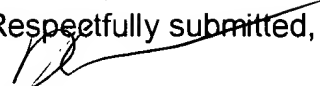
The examiner remains of the opinion that the specification and drawings are fatally defective.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/554,343
Art Unit: 3723

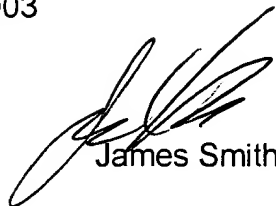
Page 6

Respectfully submitted,


Debra S. Meislin
Primary Examiner
Art Unit 3723

dsm
January 6, 2003

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